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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,824	04/27/2001	Mieko Tanaka	109358	8472

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 01/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/842,824

Applicant(s)

TANAKA ET AL.

Examiner

Lawrence D Ferguson

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Election

1. This action is in response to the provisional election mailed October 23, 2002. (Group II) Claims 13-21 were provisionally elected rendering (Group I) Claims 1-12 to a non-elected invention.

RESPONSE TO REQUEST FOR RECONSIDERATION

2. Applicant's election with traverse of recording medium (Group II) is acknowledged. The traversal is on the ground(s) that "the subject matter of all of claims 1-21 is sufficiently related that a thorough search for the subject matter of any one group of claims would encompass a search for the subject matter of the remaining claims." Thus the search and examination of the entire application could be made without serious burden. The search of the 2 classes and subclasses would entail the requisite serious burden as the search for method of making is not the same as the article search. Additionally, the steps used in the method claims would not be expected to appear in the class/subclass of the product claims. Every recording medium is not made using the same method.

The requirement is deemed proper and is therefore made **FINAL**.

Claim Rejections – 35 USC 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 13-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. In claim 13, the phrase, 'wherein the ring shaped first and second concaves with a center of said recording medium as centers' is indefinite. The phrase lacks clarity and is incoherent. Clarity is requested.

Claim Rejections – 35 USC § 103(a)

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 13-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/47140 in view of Takakuwa et al (U.S. 6,280,660).

7. WO '140 discloses a molded optical data disc (page 5, lines 5-9) comprising a substrate having a formatted surface with concentric ring (page 5, lines 15-20). WP '140 discloses a formatted information area in a central portion wherein the central portion is located between the central hold and the formatted disc substrate (page 6, lines 11-15).

The reference discloses an annular ridge extending from the disc substrate (column 6, lines 27-28) where the layer is formed of a polycarbonate resin with a height of 0.5mm (page 14, lines 24-31). In claim 13, a ridgy resin film formed in said resin film formation area is a product by process claim limitation. Additionally, in claim 17, 'said ridgy resin film is formed by supplying a resin liquid to a surface of the resin formation area and curing said resin liquid' and in claim 20, 'photoreactive curable resin is cured by irradiation of ultraviolet rays' are product by process claim limitations. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. WO '140 does not disclose the disc having a recording layer or resin layer.

Takakuwa teaches an optical recording medium (disk) that may be curved comprising a resin layer and recording film (column 4, lines 12-30). WO '140 and Takakuwa are analogous art because they are both in the field of discs. It would have been obvious to one of ordinary skill in the art to include the resin and recording layers in the optical data disc of WO '140 because WO '140 discloses its formats of optical data discs generally include DVD and CD-R's which conventionally comprise recording layers and resin layers. Additionally, Takakuwa teaches an optical disc with the desired layers of Applicant's claimed invention. Neither WO '140 nor Takakuwa teach viscosity

or glass transition. The viscosity of the resin is directly related to the moldability of the disc. Since the references are molded and comprise the film formation region, the viscosity of the resin would be expected to be the same as Applicant claims.

Additionally, the prior art does not disclose glass transition, which is directly related to the resin film. Because the reference comprises polycarbonate as instantly claimed, the glass transition would be expected to be the same as Applicant claims, absent any evidence to the contrary.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



Lawrence D. Ferguson
Examiner
Art Unit 1774

CYNTHIA H. KELLY
SUPERVISOR
TECHNICAL STAFF
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